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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/785,413  | 02/25/2004  | Shigeru Yao          | 054160-S012-02      | 9813             |
| 9629  | 7590        | 04/04/2005           | EXAMINER            |                  |
| MORGAN LEWIS & BOCKIUS LLP<br>1111 PENNSYLVANIA AVENUE NW<br>WASHINGTON, DC 20004 |             |                      |                     | VO. HAI          |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
|   |             |                      |                     | 1771             |

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/785,413             | YAO ET AL.          |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Hai Vo                 | 1771                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 April 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 15-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 15-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 25 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0225, 0409</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-24, and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2-2856. JP'856 teaches a porous film for liquid filtration comprised of a polyimide having a formula as shown at page 1 of the translation. The formula indicates that the polyimide resin film obtained from the combination of biphenyltetracarboxylic dianhydride component and a diaminodiphenylether component. The porous film has a mean pore size, and thickness within the claimed ranges. The film is fabricated by a film casting method (page 4). JP'856 discloses the polyimide film having the pores in the center and on both surfaces of the film (page 5). JP'856 does not disclose the film having the pores forming fine continuous channels reaching to both surfaces of the film in a non-linear fashion. However, it appears that the porous film is useful for liquid or water filtration, the pores would be substantially inherently interconnected to form

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continuous channels reaching to both surfaces of the film in a non-linear fashion for successful infiltration. JP'856 discloses the film having high porosity in order to obtain a higher water flux. JP'856 does not specifically disclose the film porosity. It appears that the porosity is dictated by the mean pore size and a process of forming the film. The porous film is made from a polyimide obtained from the combination of one tetracarboxylic acid component and one diamine component. The porous film has an average pore size within the claimed range. The porous film is formed by a film casting method. Therefore, it is not seen that the porosity could have been outside the claimed range as the same starting materials and the same technique are employed to form the porous film having the pore size within the claimed range. JP'856 does not specifically disclose the air resistance, heat resistance, heat shrinkage and dielectric constant. However, it appears that the porous film has the mean pore size, thickness within the claimed range. The porous film is made from the same materials and the same process as that of the present invention. The porous film substantially has a continuous channels reaching to both surfaces of the film in a non-linear fashion in the center and both surfaces of the film for successful water infiltration. It is the examiner's position that the air resistance, heat resistance, heat shrinkage and dielectric constant would be inherently present. Like material has like property. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. JP'856 does not disclose a

battery separator comprising a porous film. The preamble “battery separator has not given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Note *In re Best* 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102. Accordingly, JP'856 anticipates or strongly suggests the claimed subject matter.

4. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-2856 as applied to claims 15 and 21, in view of Dorval et al (US 5,547,833). JP'856 teaches the pores in the interior portion lay in a row at an inclination of about 30° with respect to the film thickness direction (page 5). JP'856 does not teach the pores arranged in the film substantially parallel to the film surface. Dorval, however, teaches a diffusing member containing pores oriented substantially parallel to the film surface favors lateral capillary flow within the membrane (column 10, lines 35-40). Directional pore orientation is recognized as a result-effective variable, differences in pore orientation will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such orientation is critical or provides unexpected results. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the pores with the

directional pore orientation as recited in the claims motivated by the desire to favor lateral capillary flow within the porous film, thereby optimizing the filtration performance of the porous film.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 15-24 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-31 of copending Application No. 10/784,982. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of copending Application No. 10/784,982 fully encompass the presently claimed subject matter in addition to the presence of the conductive metal layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai V.  
Tech Center 1700